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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/538,709	10/03/1995	DOUGLAS P. CERRETTI	2826-A	6869

22932 7590 07/23/2004

IMMUNEX CORPORATION  
LAW DEPARTMENT  
1201 AMGEN COURT WEST  
SEATTLE, WA 98119

EXAMINER

DEBERRY, REGINA M

ART UNIT	PAPER NUMBER
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1647

DATE MAILED: 07/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 08/538,709	<b>Applicant(s)</b> CERRETTI, DOUGLAS P.	
	<b>Examiner</b> Regina M. DeBerry	<b>Art Unit</b> 1647	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 August 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 29-61 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 53-57 is/are allowed.
- 6) ☒ Claim(s) 29-52 and 58-61 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

***Status of Application, Amendments and/or Claims***

The amendment filed 14 August 2003 has been entered in full. Claims 29-61 are under examination.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

***Withdrawn Objections And/Or Rejections***

The objection to the specification as set forth at page 2 of the previous Office Action (07 February 2003) is *withdrawn* in view of the amendment (14 August 2003).

The rejection of claims 58-60 under 35 U.S.C. 112, first paragraph, scope of enablement as set forth at pages 3-5 of the previous Office Action (07 February 2003) is *withdrawn* in view of the amendment (14 August 2003).

The rejection of claims 29-57 and 61 under 35 U.S.C. 112, second paragraph, as set forth at pages 5-6 of the previous Office Action (07 February 2003) is *withdrawn* in view of the amendment (14 August 2003).

***Priority***

Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence of the specification or in an application data sheet (37 CFR 1.78(a)(2) and (a)(5)). The

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specific reference to any prior nonprovisional application must include the relationship (i.e., continuation, divisional, or continuation-in-part) between the applications except when the reference is to a prior application of a CPA assigned the same application number.

### **Claim Rejections - 35 USC § 102(e)**

Claims 29, 32, 35, 38, 41, 44, 47 and 50 remain rejected under 35 U.S.C. 102(e) as being anticipated by Flanagan *et al.*, U S Patent No. 5,795,734. The basis for this rejection is set forth at pages 6-7 of the previous Office Action (07 February 2003).

Applicants argue that since the instant claims have been pending since 1994 and Applicant has made a prima facie showing that Applicant is entitled to judgment relative to patentee (see Cerretti 1.131 Declaration), Applicant requests that the Examiner indicate the present claims are allowable. Applicants state that pursuant to 37 C.F.R. 607, Applicant may seek to request an interference with the '734 patent.

Applicants' arguments have been fully considered but not deemed persuasive for the following reasons. If the effective filing date of the application is 3 months or less than 3 months after the effective filing date of the patent, the Applicant must submit a statement alleging that there is a basis upon which Applicant is entitled to a judgment relative to the patentee. 37 CFR 1.608(a). If the effective filing date of the application is more than 3 months after the effective filing date of the patent, Applicant must submit an affidavit under 37 CFR 1.608(b). See MPEP 715.04 and 2308.

The effective filing date of the instant application is 10/03/95 because Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120. The instant rejection cannot be overcome by an affidavit or declaration under 37 CFR 1.131. Applicant must submit an affidavit under 37 CFR 1.608(b). Please also see MPEP 2307, which explains how Applicant requests an interference with a patent.

#### **Claim Rejections - 35 USC § 135(b)**

Claims 30, 31, 33, 34, 36, 37, 39, 40, 42, 43, 45, 46, 48, 49, 51, 52, 58-61 are rejected under 35 U.S.C. 135(b) as not being made prior to one year from the date on which U.S. Patent No. 5,795,734 was granted. See *In re McGrew*, 120 F.3d 1236, 1238, 43 USPQ2d 1632,1635 (Fed. Cir. 1997) where the Court held that the application of 35 U.S.C. 135(b) is not limited to *inter partes* interference proceedings, but may be used as a basis for *ex parte* rejections.

The Examiner has determined that although the instant application was filed 10/03/95; the instant claims (claims 30, 31, 33, 34, 36, 37, 39, 40, 42, 43, 45, 46, 48, 49, 51, 52, 58-61) were first presented in Applicant's amendment, filed 6/30/00. Therefore, the instant claims were not made prior to one year from the date, which U.S. Patent No. 5,795,734 was granted. Please see MPEP 2307, which explains how the requirements of 35 USC 135(b) are met, if the claim(s) presented or identified was not present in the application until more than one year after the issue date of the patent.

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**Conclusion**


Claims 29-52 and 58-61 are rejected.

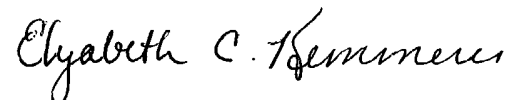
Claims 53-57 would be allowable.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Regina M. DeBerry whose telephone number is (571) 272-0882. The examiner can normally be reached on 9:00 a.m.-6:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brenda G. Brumback can be reached on (571) 272-0961. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
RMD  
6/9/04



ELIZABETH KEMMERER  
PRIMARY EXAMINER